

Application No.: 10/667,606Docket No.: 713-886AMENDMENTS TO THE DRAWINGS

In this response Fig. 2 is amended in a manner which corrects the inadvertent repeated usage of the numeral 10. To correct this, the numeral 10 which was inadvertently used to designate the charges 14 on the strip 12, has been corrected to numeral "14" in the manner shown in the appended replacement sheet.

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This is in fully and timely response to the above-identified Office Action. The above listing of claims supersedes any previous listing. Favorable reexamination and reconsideration are respectfully requested.

The Drawings

As noted above, the numeral denoting the charges has been changed to "14." This corrects the error and correctly denotes the charges using the appropriate numeral.

Rejections under 35 USC § 103

The rejection of claims 1, 2 and 13 under 35 USC § 103(a) as being unpatentable over the admitted prior art AAPA in view of Mizek et al. (hereinafter Mizek) is respectfully traversed.

The rejection is based on knowledge which can be gleaned only from the Applicant's own disclosure. Indeed, no problem per se has been expressed under the heading of "Description of the Prior Art." All that is disclosed is that greater force is needed to cock the tool as one or more additional springs are incorporated as part of the resetting mechanism . . ." There is no disclosure of the need for "excessive" force, simply that in the case of semi-automatic or fully automatic resetting systems, a force greater than with the one shot arrangements. Indeed there is no disclosure of any problem per se until the summary of the invention is entered. The disclosure of the problem which is solved by the embodiments of the invention is solely part of the disclosure of the Applicant's invention and is not available for application against the claimed subject matter as is the case in this instance.

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The rejection therefore lacks the foundation of proper motivation for the hypo to go out and consider art such that of Mizek. Attention is called to MPEP 2143.01

Suggestion or Motivation To Modify the References.

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held Improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Further, the rejection also attempts to indicate that the two pieces of prior art that are relied upon are "analogous" in that the both solve the problem of adjusting the torque and therefore the compressive force of a spring in a device. However, there is a misunderstanding of the disclosure of the prior art. The present invention is directed to providing torque which can be adjusted without high axial loads being imparted to the cocking rod. Note the disclosure at page 7 lines 1-8 which sets forth:

In the preferred embodiment, the cocking rod spring 16 is made as a relatively weak spring in axial compression as operation of the tool **does not require a high axial load to be imparted to the cocking rod 4**. However, the spring 16 is required to apply a relatively high torque to the cocking rod 4 to ensure satisfactory and safe operation of the firing mechanism. These characteristics are obtained in the preferred embodiment by the use of a relatively long compression spring which is then subject to a twist of appropriate angular extent in order to obtain the required torque loading. (Emphasis added)

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Attention is called to the fact that both axial and torsional forces are both required to be applied. The axial load requirements are not high but they are present and are not zero - note the requirement for both axial and rotational bias which is recited in the independent claims.

In Mizek, however, it is simply the torsional force alone that is sought to be provided. Axial displacement of shaft 45 is not contemplated, and there is no disclosure as to the need for such a force to be applied. Indeed, axial displacement of the shaft 45 would seem highly detrimental to the arrangement disclosed in Mizek.

The Applicant is aware of the fact that *In re Keller* (642 F.2d 413, 208 USPQ 871 (CCPA 1981)) can be cited for the proposition that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art."

However, just how/why the hypothesized person is expected to consider a transfer of the teachings of the torsional adjustment of Mizek in the arrangement disclosed in PCT/AU99/01097(WO00/35638), which is discussed under the heading of Prior Art, given the disclosure of these two references, has clearly not been established to the degree that a tenable rejection can be seen to be formulated.

Indeed, in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

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Allowable Subject Matter

The indication that claims 3-6 contain allowable subject matter is noted with appreciation.

In accordance with this indication, claim 3 has been rewritten to assume independent form.

Claims 3-6 are therefore submitted to stand in *prima facie* condition for allowance.

New Claims

New independent claims 15 and 16 are added in this response. Support for these claims is found in the specification, claims and drawings as originally filed and are allowable for at least the reason they define subject matter which is neither disclosed by nor suggested by the art of record.

Conclusion

The claims as they currently stand before the PTO are allowable for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,
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